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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,753	03/04/2004	Tsutomu Fujimura	249976US0	5264
22850 7590 01/31/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
			EXAMINER LEITH, PATRICIA A	
			ART UNIT 1655	PAPER NUMBER
			NOTIFICATION DATE 01/31/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

## Office Action Summary

Application No.

10/791,753

Applicant(s)

FUJIMURA, TSUTOMU

Examiner

Patricia Leith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/30/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, 5, 8, 11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6, 9, 10, 12 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/07 has been entered.

Claims 1-6 and 8-17 are pending in the application.

Applicant has cancelled the species previously searched on the merits; i.e., *Petroselinium sativum*. Therefore, the Examiner has chosen another species for examination on the merits; an extract of *Curcuma longa* (rhizome).

### ***Election/Restrictions***

Claims 1-3 and 5 remain withdrawn from the merits as being drawn to an invention nonelected with traverse in Paper No. 4/18/05.

Because claims 8, 11 and 13 are directed toward a non-elected invention (i.e., plant part or plant), these claims have been withdrawn from consideration on the merits.

Claims 4, 6 and 9-10, 12 and 14-17 were examined on their merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a previous Office Action.

***Claim Rejections - 35 USC § 102***

Claims 4, 9, 10, 12, 14, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Santhanam et al. (US 6,277,881 B1).

Santhanam et al. (US 6,277,881 B1) disclosed the use of extracts of turmeric (powdered rhizome of *Curcuma longa*) in topically applied applications in order to decrease stinging in cosmetic/topically applied pharmaceutical agents containing hydroxy acids (see entire reference). With regard to turmeric, Santhanam et al. explained:

Turmeric is a powdered rhizome of the plant *Curcuma longa* Linn. The biological activities of turmeric have generally been attributed to curcumin, a component of turmeric extract. Curcumin has been reported to have anti-inflammatory and anti-oxidant activity (see column 1, lines 27-31).

Santhanam et al. specifically teach an oil-in-water emulsion (a cream) containing 0.5% of an extract of turmeric (see Example 4, col. 9 as presented also below).

#### EXAMPLE 4

A typical oil-in-water emulsion within the scope of the invention is as follows:

chemical name	wt %
propylene glycol	1.0
glycerin	1.0
hydroxyethylcellulose	0.5
magnesium aluminum silicate	0.5
imidazolidinyl urea	0.5
tetrasodium EDTA	0.05
petrolatum	2.0
isopropyl palmitate	5.0
dimethicone	0.5
cholesterol	0.5
cetyl alcohol	0.5
isostearic acid	3.0
retinyl palmitate	0.1
peg-40 stearate	1.0
peg-100 stearate	1.0
sorbitan stearate	1.0
turmeric extract	0.5
glycolic acid	7.0
ammonium hydroxide	to pH 4.0
water DI	qs to 100%

***Claim Rejections - 35 USC § 103***

Claims 4, 6 and 9-10, 12 and 14-17 rejected under 35 U.S.C. 103(a) as being unpatentable over Santhanam et al. (US 6,277,881 B1).

The teachings of Santhanam et al. were discussed *supra*. Santhanam et al. did not specifically teach the measurements of the area of the skin which was to be treated.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F2d 454,456,105 USPQ 233; 235 (CCPA 1955). see MPEP § 2144.05 part II A. It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to determine all operable and optimal amounts of *Curcuma longa* rhizome (turmeric) extract to apply to the skin dependant on the surface area afflicted. Santhanam et al. make clear that first, extracts of turmeric were known in the art to have anti-inflammatory and anti-oxidant activity and second, that extracts of turmeric were shown to decrease the irritant effects of hydroxy acids in cosmetic compositions (see citations, *supra*). Thus, turmeric extract is considered an art-recognized result-effective variable which would have been routinely determined and optimized in the pharmaceutical art. Further, if there are any differences between Applicant's claimed method and that suggested by the teaching of the prior art, the

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differences would be appear minor in nature. Although the prior art does not specifically teach the measurements of the surface area to be treated, the ordinary artisan would have been motivated to vary the amount of product administered to the skin dependant on the amount of surface area in need of treatment in order to maximize efficacy of the cosmetic composition.

The Supreme court has acknowledged that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. **If a person of ordinary skill can implement a predictable variation..103 likely bars its patentability...**if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill. A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions...

**...the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results** (see *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 U.S. 2007) emphasis added.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

### **Conclusion**

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No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Leith whose telephone number is (571) 272-0968. The examiner can normally be reached on Monday - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia Leith  
Primary Examiner  
Art Unit 1655

January 18, 2008

A handwritten signature in black ink, appearing to read 'Patricia Leith', with a stylized flourish at the end.